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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,566	03/02/2004	Axel E. Elfner	END920030098US1	3099
30400 7590 02/27/2009 HESLIN ROTHENBERG FARLEY & MESITI P.C. 5 COLUMBIA CIRCLE ALBANY, NY 12203			EXAMINER POLLACK, MELVIN H	
			ART UNIT 2445	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<i>Office Action Summary</i>	Application No.	Applicant(s)	
	10/791,566	ELFNER, AXEL E.	
	Examiner	Art Unit	
	MELVIN H. POLLACK	2445	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 17 November 2008 have been fully considered but they are not persuasive. An analysis of the arguments is provided below.
2. Applicant continues to argue that Afergan and Yoshida are not analogous art (Pp. 2 - 3). The examiner stands upon its prior explanation of the statutory language, current case law and policy analysis: the determination of what is analogous is not supposed to be anywhere near as narrow as the applicant insists. In particular, the examiner in seven years of practice and three years of law school has never heard of anything resembling applicant's "different issue" test. Meanwhile, the Federal Circuit has again ratified that analogousness is broader than the applicants insist (*Rothman v. Target Corp.*). The examiner will not deviate from his initial determination as to what is analogous. Applicant is now free to bring this to the board if he so chooses.
3. Applicant also mischaracterizes Afergan, which is to be wholly interpreted as a content distribution network (CDN) wherein mail is one of the types of content to be served. While it is true that one of the goals is to protect content servers from outside attacks, this alone does not override Afergan's capability of automatically determining whether content is to be sent nor does it obviate the server's capacity to distribute content based on automatic checking by an external unit.
4. In response to applicant's argument that Afergan (and all other cited art) is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was

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concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Afergan, Yoshida, etc. have all been clearly shown to be both within the field of the applicant's endeavor and pertinent to the applicant's problem: transmitting data from a server on a restricted network to a communications unit on a non-restricted network.

5. In response to applicant's argument that Afergan does not disclose an intended use, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. That said, the claims are clearly drawn to a restricted network which receives an incoming request (the external unit's automatic and periodic check) and determines whether there is mail (or other content) to be sent. That it also protects the server from attacks shows that it is a restrictive network but does not indicate a different intent.

6. In response to applicant's argument that Afergan and Yoshida may not be properly combined (P. 4), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

7. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

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combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

8. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

9. In this case, even if Afergan only filtered incoming information and Yoshida never received an incoming message (and a mere prima facie view of the art clearly indicates that both Afergan and Yoshida receive requests and produce content in response), this fact alone would not destroy the combination. In this case, one of ordinary skill in the art would recognize the immense benefit of improving Afergan by using Yoshida: the motivation to provide greater protection and lower network stresses.

10. Applicant then argues that Afergan does not expressly disclose "automatically checking periodically by a communications unit external to a restricted communications network (Pp. 4-5)." The examiner reminds the applicant that the test for express teaching is not that the art uses the necessary phrase but that the teaching matches the function, structure and definition of the claim limitation. External units (CDNs) constantly (automatically and periodically) request information from the internal units (origin servers) based on end-user requests, and the origin

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server determines whether there is content to be sent, i.e. if the content is stale (Paras. 24 – 25).

The use of IP addresses and metadata is to help the CDN make these automatic and periodic requests – to determine what the CDN should check for. (See also Paras. 9 – 11).

11. Applicant may wish to clarify steps determining whether there is content to be sent. At present, Afergan teaches the broadest reasonable interpretation.

12. Applicant then argues that the external unit is part of the restricted network (P. 5).

Applicant confuses the development of boundaries in the network with being part of the network, but a review of the art clearly shows a separation of networks (Figs. 1, 4A; Paras. 22, 28-29 and 38-39).

13. Applicant then argues that Yoshida does not expressly disclose that the mail is sent from the restricted network to the external unit, but that the client is on the restricted network (Pp. 5-6). Such a teaching is not necessary and therefore is not part of the rejection. But for the purpose of advancing prosecution, examiner notes that Yoshida does in fact teach this limitation. While it is true that the client (#14) is protected by a firewall, the server (#30) is the true restricted network as it utilizes proxies and authentication to protect itself from intruders from other parts of the internet.

14. Finally, re claim 11, applicant argues that Afergan does not comprise parsing the mail into multiple messages (P. 6). If each message is analogized as a content file, then the limitation is taught by applicant's own admission that the content may be accessed on a per-file basis. But

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even if the message is analogized as part of a content file, Afergan teaches that an end user may need to receive content from multiple CDNs. The applicant may wish to consider clarifying amendments to this limitation.

15. The rejection is maintained for the reasons above. This action is final.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-3, 5, 6, 8, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Afergan et al. (2004/0010601) in view of Yoshida (2004/0049546).

18. For claim 1, Afergan teaches a method (abstract) of facilitating the sending of mail from a restricted communications network (Paras. 1-20), said method comprising:

- a. automatically checking periodically (Paras. 20-24) by a communications unit external (Fig. 4A, #406-410) to a restricted (Paras. 27-30) communications network (Fig. 4A, #400-404) whether mail (Para. 28; content particularized to example of mail server) of the restricted communications network is to be sent (Paras. 23-24); and
- b. retrieving by the communications unit the content (Para. 28) from the restricted communications network, in response to there being mail to be sent (Paras. 21-24);
- c. wherein the automatically checking comprises sending a request from a program of the communications unit to a program of the restricted communications network

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(Paras. 29-30) inquiring as to whether there is content to be sent, and wherein the program of the restricted communications network checks a data structure to determine whether there is content in the data structure to be sent (Paras. 23-35).

19. Afergan does not expressly disclose that the content being sent is mail messages, or that the system is checking in particular for mail messages to be sent. Yoshida teaches a method and system (abstract) of mail delivery (Paras. 1-23) through an external proxy server (Paras. 24-26) from a server on a restricted network (Paras. 27-32, 41). In particular, Yoshida checks periodically to see if there is new mail to be sent (bulk mail data 100) and retrieves it if there is (Paras. 33-39, 43). At the time the invention was made, one of ordinary skill in the art would have added Yoshida's mail server and content retrieval system to Afergan's content retrieval system with mail server embodiment in order to reduce Afergan's content network load stresses (Para. 5) and to further explain the mail server embodiment.

20. For claim 2, Afergan teaches wherein the sending of the request is via an inbound connection from the communications unit to the restricted communications network over an available port (Paras. 27-39, with emphasis on Paras. 28-29 and 32-34).

21. For claim 3, Afergan teaches that the retrieving comprises having the program of the restricted communications network serve the mail to the program of the communications unit via the available port (Paras. 27-39, with emphasis on Paras. 28-29 and 32-34).

22. For claim 5, Afergan teaches that the retrieving comprises having the program of the restricted communications network provide the mail in the data structure to the communications unit (Para. 28).

23. For claim 6, Afergan teaches providing the mail to the data structure (Para. 28).

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24. For claim 8, Afergan teaches forwarding the mail (Para. 28) from the communications unit to one or more receivers (Paras. 23-24).

25. For claim 10, Afergan teaches that a receiver of the one or more receivers comprises an intermediary to facilitate forwarding the mail to an intended recipient of the mail (Paras. 23-24).

26. For claim 11, Afergan teaches that the forwarding comprises parsing the mail into one or more messages and sending the one or more messages to the one or more receivers (Paras. 21-25).

27. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Afergan and Yoshida as applied to claims 1, 6 above, and further in view of Banister et al. (7,219,131).

28. For claim 7, Afergan and Yoshida do not expressly disclose that the providing is performed by a queue program of the restricted communications network, and wherein the queue program receives the mail from another program of the restricted communications network, said another program capable of receiving mail from one or more communications units of the restricted communications network. Banister teaches a method and system (abstract) of determining e-mails for appropriate delivery (col. 1, line 1 - col. 5, line 65; col. 20, line 33 - col. 28, line 25) that includes delivery decision making procedures (col. 5, line 65 - col. 20, line 33), and includes the queuing procedure (col. 10, line 50 - col. 12, line 40). At the time the invention was made, one of ordinary skill in the art would have added these features in order to protect from the security problem known as spam (col. 2, line 50 - col. 3, line 5).

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29. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Afergan and Yoshida as applied to claims 1, 8 above, and further in view of Mizuno et al. (2006/0031927).

30. For claim 9, Afergan and Yoshida do not expressly disclose that a receiver of the one or more receivers comprises an intended recipient of the mail. Mizuno teaches a method and system (abstract) of transferring communications data (Paras. 1-25) from a restricted network to an external server (Paras. 26-30) that includes this limitation (Paras. 31-34). At the time the invention was made, one of ordinary skill in the art would have added Mizuno in order to improve seamless access to files behind an Afergan firewall (Paras. 13-14).

31. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Afergan and Yoshida as applied to claims 1, 8, 11 above, and further in view of Clarke et al. (7,043,240).

32. For claim 12, Afergan and Yoshida do not expressly disclose that the manner in which a message is sent to a receiver is dependent on the type of receiver. Clarke teaches a method and system (abstract) of providing the messages (col. 1, line 1 – col. 3, line 55) that comprise the limitations (col. 3, line 55 – col. 7, line 30). At the time the invention was made, one of ordinary skill in the art would have added Clarke's receivers in order to handle a variety of legacy protocols (col. 1, lines 15-55).

Conclusion

16. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELVIN H. POLLACK whose telephone number is (571)272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. H. P./
Examiner, Art Unit 2445
26 February 2009

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/Larry D Donaghue/

Primary Examiner, Art Unit 2454